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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,715	03/31/2004	Robert P. Morris	1226/US	7428
49278 7590 10/06/2008 SCENERA RESEARCH, LLC 111 Corning Road Suite 220 Cary, NC 27518				
EXAMINER				
DAFTUAR, SAKET K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/813,715

**Applicant(s)**

MORRIS, ROBERT P.

**Examiner**

SAKET K. DAFTUAR

**Art Unit**

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This office action is supplemental Final office action responsive to the pre-appeal filed on July 21<sup>st</sup>, 2008. The amendment submitted on June 24<sup>th</sup>, 2008 has been entered. Claims 1-38 are presented for the examination.

***Response to Arguments***

2. Applicant's arguments filed January 9<sup>th</sup>, 2008 have been fully considered but they are not persuasive. Applicant continues to argue in substance that:

a. Geiger fails to disclose or even suggest "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected" and argues that static buttons that are presented every time.

In response to applicant argument a), Geiger discloses Automated post office based rule analysis of e-mail messages and other data objects for controlled distribution in network environments where various software products provide for automatic deferral and review of e-mail messages and other data objects in a networked computer system, by applying business rules to the messages as they are processed by the post offices. Using the same analysis, provided by applicant representative, one having ordinary skill in the art would recognize "Gatekeeper" with different gatekeeper actions and roles. Such roles or action could be a "review" or "release" as shown in action gatekeeper Graphical User Interface. For example, Figure 19 is "Gatekeeper" GUI where

gatekeeper has an access to take available action for Gated messages and therefore, all graphic or action buttons, 1907...1915 , are displayed. These buttons are displayed because the electronic message follow the rule to display all graphic buttons and one having ordinary skill in the art would clearly recognize this without any brief clarification. Similarly when gatekeeper wants to create a message and wants to review it before sending to appropriate sender, Note the "review" graphic button is not displayed, it follows the rule to display other graphic buttons except "review" and one having ordinary skill in the art must recognize this. Therefore, applicant argument that all buttons are static and they do not follow the electronic filter criteria is not correct as each gatekeeper tab or interface has its own criteria and each criteria has its own way of matching graphic action buttons as shown clearly in figures 19-20. Similarly, one having ordinary skill in the art would recognize the list of all graphic action displayed under certain tab or interface as an action list represented by "graphic icons". In addition the same user interface is available for client for their use where the system is receiving message for their client and storing the messages for the recipients.

"In e-mail systems which use mail servers, post offices deliver incoming messages to a mail server which persistently stores the messages for the recipients. The recipients access the messages via the client applications. In some systems where mail servers are not used, the post offices deliver e-mail messages directly to the client applications. The

e-mail client applications are end-user applications for creating, reading, and managing a user's individual e-mail account" (Background of Invention)

Therefore, applicant argument that Geiger fails to disclose electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected and applicant argument that all graphic buttons are static is not persuasive.

b. applicant continues to argue that Geiger fails to teach "placing the electronic message with the action list in the recipient's inbox", "inserting computer code into the electronic message if the electronic message matches the criteria", "inserting a graphic associated with each action in the action list into the electronic message" and "the criteria for filtering is customizable for a recipient" as disclosed in dependent claims 3-5, 7-9, 11-12 and 14.

In response to applicant argument b), Geiger discloses "placing the electronic message with the action list in the recipient's inbox" (see column 19, line 52 - column 21, line 24, examiner considers Action List Processing message with respect to the rule base and invokes the distribution engine based on default priority levels for actions, the action list and distributing engine are coupled with message index and message store), "inserting computer code into the electronic

message if the electronic message matches the criteria" (examiner considers graphics can be a plurality of buttons displayed as part of the electronic message, specification page 7 such as action buttons at GUI, see Figure 19-20, blocks 1907,1909,1911,1913,1915 are graphic buttons, column 23, lines 5-36), "inserting a graphic associated with each action in the action list into the electronic message" (examiner considers graphics can be a plurality of buttons displayed as part of the electronic message, specification page 7 such as action buttons at GUI, see Figure 19-20, blocks 1907,1909,1911,1913,1915 are graphic buttons, also see column 21, line 26 – column 22 line 10), and "the criteria of filtering and action is customizable for a recipient" (see Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Geiger et al U.S. Patent Number 6,073,142 (hereinafter Geiger).

As per claim 1, Geiger discloses (a) receiving an electronic message [incoming messages] for a client [for the recipient] (see column 1, line 49-57);(b)

determining if the electronic message matches at least one criteria of a filter [rules, business rules], wherein at least one action is associated with the filter (Abstract, column 3, lines 30-61; examiner considers “Each business rule describes a particular action to be applied to an e-mail message in response to either attributes of the e-mail message or performance data of the post office. For example, a business rule may specify actions such as deleting the e-mail message, gating the e-mail message for further review, copying the e-mail message, returning the e-mail message to its sender without delivering it....” as electronic messages matches at least one filtering criteria and action associated with the filter); and (c) if the electronic message matches the criteria, displaying a graphic associated [“graphic buttons”] with the action when the electronic message is viewed at the client and executing the action if the graphic [“graphics can be a plurality of buttons displayed as part of the electronic message”, specification page 7 such as action buttons at GUI] is selected (Figures 19-20s a screen shot of graphical user interface of action gatekeeper that shows graphic buttons and rules status [filtering status] for each message, see Figure 19-20, blocks 1907, 1909, 1911, 1913, 1915 are graphic buttons associated with business rules, column 23, lines 5-36).

As per claim 2, Geiger discloses (b1) adding the action associated with the filter to an action list for the electronic message, if the electronic message matches the criteria (see figures 6-8 for editing checkpoint rules and figures 16-17 for editing roles, column 9, line 60 – column 10, line 31).

As per claim 3, Geiger discloses (b1i) receiving a plurality of filters configured for a recipient of the electronic message (see figures 6-8 for checkpoint rules and figures 16-17 for editing roles, column 9, line 60 – column 10, line 31; tables 1-7); (b1ii) comparing the electronic message against criteria of each of the plurality of filters (column 18, line 56- column 19, line 51); (b1iii) for each filter with criteria matching the electronic message, adding an action associated with the filter to an action list [see column 19, line 52 – column 21 line 24] for the electronic message (column 18, line 56- column 19, line 51); and (b1iv) placing the electronic message with the action list in the recipient's inbox (see column 19, line 52 – column 21 line 24).

As per claim 4, Geiger discloses (c1) inserting computer code into the electronic message if the electronic message matches the criteria, wherein the computer code displays the graphic [graphics can be a plurality of buttons displayed as part of the electronic message, specification page 7 such as action buttons at GUI] associated with the action when the electronic message is viewed at the client and executes the action if the graphic is selected ((see Figure 19-20, blocks 1907, 1909, 1911, 1913, 1915 are graphic buttons, column 23, lines 5-36)).

As per claim 5, Geiger discloses (c1i) receiving from the client a request for the electronic message; (c1ii) obtaining the electronic message from the recipient's inbox; and (c1iii) inserting a graphic associated with each action in the

action list into the electronic message (column 1, line 35 - column 2, line 14, see figure 19-20 GUI for displaying inbox).

As per claim 6, Geiger discloses (c1) determining that the client [sender or recipient] is a supported client;(c2) adding the action list to the electronic message; and (c3) sending the electronic message to the client (see column 23, lines 5- 52).

As per claim 7, Geiger discloses (d) receiving a selection of the graphic [GUI]; (e) checking for a plug-in associated with the action at the client [user application program]; and (f) invoking the plug-in, if the plug-in is found (see column 21, line 26 – column 22 line 10).

As per claim 8, Geiger discloses (g) requesting the plug-in from a plug-in server, if the plug-in is not found; (h) receiving the plug-in from the plug-in server [server loads and executes]; (i) installing the received plug-in; and (j) invoking the plug-in (see column 21, line 26 – column 22 line 10).

As per claim 9, Geiger discloses (d) receiving a selection of the graphic; (e) sending an action request for the action associated with the selected graphic to a server; and (f) processing a response to the request from the server (column 23, lines 5-36).

As per claim 10, Geiger discloses (g) receiving the action request by the server ;(h) invoking a plug-in [application program] associated with the action; and (i) sending a response to the action request to the client (column 1, line 35 - column 2, line 14; see column 21, line 26 – column 22 line 10).

As per claim 11, Geiger discloses the criteria of the filter are customizable for a recipient (see Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules).

As per claim 12, Geiger discloses the action is customizable for a recipient (see Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules).

As per claim 13, Geiger discloses the determining step (b) is performed at a mail server (column 1, line 25 – column 2, line 44).

As per claim 14, Geiger discloses the determining step (b) is performed at the client (column 1, line 25 – column 2 line 44).

As per claim 15, Geiger discloses the determining step (b) is performed at a relay [post office/mail servers] server (column 1, line 25 – column 2 line 44).

As per claim 16, Geiger discloses a cellular phone; a personal computer; a personal digital assistant; and an image capture device (see abstract, computer system).

As per claim 17, Geiger discloses the method of claim 1, wherein the electronic message comprises a file attachment, wherein the file attachment comprises an image filter (see figure 14, block 1412 for attachments rule).

As per claims 18-34, claims 18-34 are computer readable medium claims of method claims 1-17, respectively. They do not teach or further define over the limitation as recited in claims 1-17. Therefore, claims 18-24 are rejected under same scopes as discussed in claims 1-17, supra.

As per claims 35-36, claims 35-36 are system claims of method claims 1, and 7-8. Therefore, claim 35 – 36 also recites the limitation as discussed in claims 1 and 7-8, supra. In addition to method claims limitation 1 and 7-8, claims 35-36 further discloses a storage medium, mail server and plug-in server for storing filters and application programs [see column 1, line 25 – column 2 line 44].

As per claims 37-38, claims 37-38 are system claims of claims 1-17 and 35-36, respectively. They do not teach or further define over the limitation as recited in claims 1-17 and 35-36. Therefore, claims 37-38 are rejected under same scopes as discussed in claims 1-17 and 35-36, supra.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Computer Code for Removing Junk Email Messages by Pang U.S. Patent Number 6,167,434.
  - b. Method and Apparatus for Providing Automatic E-Mail Filtering Based on Message Semantics, Sender's E-mail ID and User's Identity by Mastrianni U.S. Patent Number 6,941,466 B2.
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saket K. Daftuar whose telephone number is 571-272-8363. The examiner can normally be reached on 8:30am-5:00pm M-W.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K. D./

Examiner, Art Unit 2151

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151